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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 09/886,309   | 06/21/2001  | Yu-Suk Yun           | 678-696             | 5597             |
| 28249  | 7590        | 06/14/2005           | EXAMINER            |                  |
| DILWORTH & BARRESE, LLP<br>333 EARLE OVINGTON BLVD.<br>UNIONDALE, NY 11553 |             |                      | PHAN, MAN U         |                  |
|  |             |                      | ART UNIT            | PAPER NUMBER     |
|  |             |                      | 2665                |                  |

DATE MAILED: 06/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/886,309

Applicant(s)

YUN ET AL.

Examiner

Man Phan

Art Unit

2665

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 February 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6,15-17,20,21,36,38,39,41 and 42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6,15-17,20,21,36,38,39,41 and 42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 6/26/03, 10/18/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### ***DETAILED ACTION***

1. The application of Yun et al. for an "Apparatus and method for gating transmission of a data rate control channel in an HDR mobile communication system" filed 06/21/2001 has been examined. This application claims foreign priority based on the applications 2000-34335 dated 06/21/2000, 2000-37457 dated 06/27/2000, 2000-38084 dated 07/04/2000 and 2000-45394 dated 07/27/2000 filed in Republic of Korea. Responsive to the restriction requirement filed on 02/09/2005, affirmation of the election has been made by applicant, and a provisional election was made without traverse to prosecute the invention of group I, claims 1-6, 15-17, 20-21, 36, 38-39 and 41-42. Claims 7-13, 18-19, 22-35 and 37, 40 are withdrawn from further consideration by the Examiner, 37 C.F.R. ' 1.142(b), as being drawn to a non-elected invention. Claims 1-6, 15-17, 20-21, 36, 38-39 and 41-42 are pending in the application.

### ***Claim Objections***

2. Claims 15 and 16 are objected to because of the following informalities: These claims depend on the withdrawn claim 14. For advance prosecution of the Application, the Examiner assumes these claims depend from claim 15. Appropriate correction is required.

### ***Double Patenting***

3. A rejection based on double patenting of the "same invention" type finds its support in

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the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain : patent therefor ..." (Emphasis added). Thus, the term "same invention" in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-6, 15-17, 20, 21, 36, 38, 39, 41, 42 of the present application Serial No. 09/886,309 (hereinafter Application '309) rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-30 of U.S. Patent No. 6,782,271 (hereinafter patent '271) since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The claims are identical and they are not patentably distinct from each other because the subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent, since the patent and the application are claiming common subject matter. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are equivalent in scope and embodiment. The language of the two claims is substantially identical and is equivalent in functioning. All of the structural elements of the patent claims are present in the pending claims, defined with either identical or equivalent language. Additionally, the functional language, scope and embodiment reflect identical operation, purpose, application, and environment.

With respect to the specific limitations, claim 1 of patent '271 is equivalent to the pending claims of Application '309 with measuring power over a reverse DRC channel, determining a data rate associated with the channel by calculating a difference between the measured power with the reference values, and transmitting the determined data rate.

Furthermore, there is no apparent reason why applicant was prevented from presenting

claims corresponding to those of the instant application during prosecution of the application which matured into a patent. It has been held that the omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before. In re Karlson, 136 USPQ 184 (CCPA). Also note Ex parte Rainu, 168 USPQ 375 (Bd. App. 1969); omission of a reference element whose function is not needed would be obvious to one skilled in the art.

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Butler (US#6,545,989) discloses a transmit gating in a wireless communication system.

Bender (US#6,891,812) discloses a method and apparatus for data rate control in a communication system.

Ahn (US#6,901,254) discloses a method for selecting base transceiver system in communication system.

Kanada et al. (US#5,793,802) discloses a system including mobile radio station and base radio station.

Kanerva et al. (US#5,793,744) discloses a multichannel high speed data transfer.

Chen et al. (US#6,373,823) discloses a method and apparatus for controlling transmission power in a potentially transmission gated or capped communication system.

Huh et al. (US#2002/0021692) discloses a method and apparatus for transmitting data rate control information in mobile telecommunication system for packet data transmission.

Yun et al. (US#2002/0012385) discloses a apparatus and method for reporting service load to mobile station in mobile telecommunication system.

Huh et al. (US#2002/0018446) discloses a method and apparatus for controlling packet transmission in a mobile telecommunication system.

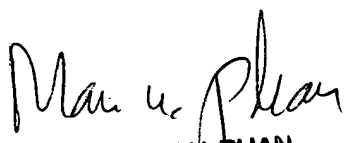
7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Phan whose telephone number is (571) 272-3149.

The examiner can normally be reached on Mon - Fri from 6:00 to 3:00 EST. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Huy Vu, can be reached on (571) 272-3155. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have any questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at toll free 1-866-217-9197.

Mphan

06/10/2005.

  
**MAN U. PHAN**  
**PRIMARY EXAMINER**